



04-16-04 C mag

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IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

APPLICANT(S):	Robert P. Otiilar et al.
APPLICATION NO.:	09/683,861
FILING DATE:	February 22, 2002
TITLE:	System and Methods for Localizing and Analyzing Samples on a Bio-Sensor Chip
EXAMINER:	Ludlow
GROUP ART UNIT:	1743
ATTY. DKT. NO.:	None

CERTIFICATE OF MAILING/TRANSMISSION

I hereby certify that this correspondence is being deposited on the date shown below with the United States Postal Service as first class mail in an envelope addressed to: Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: 4/14/04 By: R. Otiilar
Robert P. Otiilar

COMMISSIONER FOR PATENTS
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

SIR:

Responsive to the Office Action dated January 15, 2004 received in the above-identified patent application, Applicants elect Group III (claims 39-41) with traverse. Included with this Response is a Request for Extension of Time for 2 months accompanied by the appropriate fee. This Response is "timely filed." Applicants respectfully request consideration of the claims in the above-identified application for the purpose of putting the application in condition for allowance.

A restriction requirement is proper where more than one invention is claimed and the inventions are independent or distinct, and failure to restrict imposes a serious burden on the examiner. See MPEP at 803. In the instant case, Examiner improperly restricted the claims as defined in the Office Action of January 15, 2004.

According to the MPEP, section 803, "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes

claims to independent or distinct inventions.” In the Office Action of January 15, 2004, Examiner divided the invention into four separate Groups stating that the Groups have “acquired a separate status in the art as shown by their different classification.” However, three of the Groups, (Groups I, II, and IV) are listed by the Examiner as being not only in the same class, but also in the same subclass. Thus, these Groups could not have “acquired a separate status in the art as shown by their different classification.” According to the MPEP section 808.02, “separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.” The Examiner did not cite any patents in the response of January 15, 2004.

Additionally, the Examiner has given no explanation for why Group III is listed as a separate class and subclass from Groups I, II, and IV. According to the MPEP section 808.02, the Examiner “must show by appropriate explanation” the separate classification of the identified Groups. Thus, the Examiner must show that “each distinct subject has attained recognition in the art as a separate subject for inventive effort and also a separate field of search.” The Examiner has provided no explanation for the classification imposed on Group III, or the classification imposed on Groups I, II, or IV. The Examiner has not provided support showing that the four Groups have acquired a separate status in the art, nor has the Examiner indicated that the Groups require different fields of search. Therefore, restriction was improper and should be withdrawn.

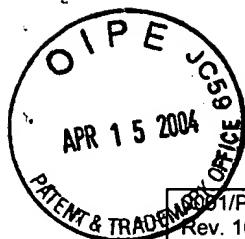
Consideration of the claims is respectfully requested, and a notice of allowance is earnestly solicited. If the Examiner has any questions concerning this Response, please contact the Applicant at (415) 317-2008.

Respectfully submitted,



ROBERT P. OTILLAR

Dated: 4/14/04



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U.S. Department of Commerce Patent and Trademark Office		Application Number 09/683,861
		Filing Date 02/22/02
		First Named Inventor Storek
		Group Art Unit Number 1645
		Examiner Name Ludlow
Total Number of Pages in This Submission 1		Attorney Docket Number none

ENCLOSURES <i>(check all that apply)</i>	
<input checked="" type="checkbox"/> Fee Transmittal Form (in duplicate) <input type="checkbox"/> Check Enclosed	<input type="checkbox"/> Issue Fee Transmittal
<input checked="" type="checkbox"/> Return Receipt Postcard	<input type="checkbox"/> Letter to Chief Draftsperson
<input type="checkbox"/> Response to Notice to File Missing Parts	<input type="checkbox"/> Formal Drawing(s): [] Sheet(s) of Figure(s) []
<input type="checkbox"/> Assignment & Recordation Cover Sheet	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Declaration	<input type="checkbox"/> Appeal Communication to Group <i>(Appeal Notice, Brief, Reply Brief)</i>
<input type="checkbox"/> Power of Attorney	<input type="checkbox"/> Certified Copy of Priority Document(s)
<input type="checkbox"/> Application Data Sheet	<input type="checkbox"/> After Allowance Communication to Group
<input type="checkbox"/> Information Disclosure Statement & PTO/SB/08A <input type="checkbox"/> Copies of IDS Cited References	<input checked="" type="checkbox"/> Response to Restriction Requirement <hr/> <hr/> <hr/> <hr/> <hr/> <hr/>
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<input type="checkbox"/> Revocation and Substitute Power of Attorney	

REMARKS:

SIGNATURE OF ATTORNEY OR AGENT	
Signature: <i>RPOZ</i>	
Attorney/Reg. No.: <i>Robert O'Ziller</i>	Dated: 4/14/04

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Signature: <i>RPOZ</i>	
Typed or Printed Name: <i>Robert O'Ziller</i>	Dated: 4/14/04
Express Mail Mailing Number (optional):	



FEE TRANSMITTAL for FY 2004		<i>Complete if Known</i>	
Patent fees are subject to annual revision.		Application Number	09/683,861
<input checked="" type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27		Filing Date	02/22/2002
		First Named Inventor	Otillar
		Examiner Name	Ludlow
		Art Unit	1743
TOTAL AMOUNT OF PAYMENT	(\\$) 210.00	Attorney Docket No.	None

METHOD OF PAYMENT (check all that apply)		FEE CALCULATION (continued)																																																																																																																																																																																																	
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ADDITIONAL FEES <table border="1"> <thead> <tr> <th colspan="2">Large Entity</th> <th colspan="2">Small Entity</th> <th>Fee Description</th> <th>Fee Paid</th> </tr> <tr> <th>Fee Code</th> <th>Fee (\$)</th> <th>Fee Code</th> <th>Fee (\$)</th> <th></th> <th></th> </tr> </thead> <tbody> <tr><td>1051</td><td>130</td><td>2051</td><td>65</td><td>Surcharge - late filing fee or oath</td><td></td></tr> <tr><td>1052</td><td>50</td><td>2052</td><td>25</td><td>Surcharge - late provisional filing fee or cover sheet</td><td></td></tr> <tr><td>1053</td><td>130</td><td>1053</td><td>130</td><td>Non-English specification</td><td></td></tr> <tr><td>1812</td><td>2,520</td><td>1812</td><td>2,520</td><td>For filing a request for ex parte reexamination</td><td></td></tr> <tr><td>1804</td><td>920*</td><td>1804</td><td>920*</td><td>Requesting publication of SIR prior to Examiner action</td><td></td></tr> <tr><td>1805</td><td>1,840*</td><td>1805</td><td>1,840*</td><td>Requesting publication of SIR after Examiner action</td><td></td></tr> <tr><td>1251</td><td>110</td><td>2251</td><td>55</td><td>Extension for reply within first month</td><td></td></tr> <tr><td>1252</td><td>420</td><td>2252</td><td>210</td><td>Extension for reply within second month</td><td>210</td></tr> <tr><td>1253</td><td>950</td><td>2253</td><td>475</td><td>Extension for reply within third month</td><td></td></tr> <tr><td>1254</td><td>1,480</td><td>2254</td><td>740</td><td>Extension for reply within fourth month</td><td></td></tr> <tr><td>1255</td><td>2,010</td><td>2255</td><td>1,005</td><td>Extension for reply within fifth month</td><td></td></tr> <tr><td>1401</td><td>330</td><td>2401</td><td>165</td><td>Notice of Appeal</td><td></td></tr> <tr><td>1402</td><td>330</td><td>2402</td><td>165</td><td>Filing a brief in support of an appeal</td><td></td></tr> <tr><td>1403</td><td>290</td><td>2403</td><td>145</td><td>Request for oral hearing</td><td></td></tr> <tr><td>1451</td><td>1,510</td><td>1451</td><td>1,510</td><td>Petition to institute a public use proceeding</td><td></td></tr> <tr><td>1452</td><td>110</td><td>2452</td><td>55</td><td>Petition to revive - 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SUBMITTED BY		Complete (if applicable)		
Name (Print/Type)	<i>Robert O'tillar</i>	Registration No. (Attorney/Agent)	Telephone <i>415-317-2088</i>	
Signature	<i>RO'TILLAR</i>		Date	<i>4/14/04</i>